

REMARKS**INTRODUCTION**

In accordance with the foregoing, the specification and claim 1, 17, 20, 21, 23 and 24 have been amended. No new matter has been submitted.

Claims 1-29 are pending and under consideration.

OBJECTION TO THE SPECIFICATION

The specification has been objected to for the typographical error in paragraph [0031]. As amended above, this error has been corrected. Therefore, withdrawal of this objection is respectfully requested.

OBJECTION TO THE CLAIMS

Claims 1-13 stand objected to because claim 1 failed to recite "beam" after incident on line 5 of independent claim 1, corresponding to the recitation "an incident beam" on line 3 of claim 1. This correction of the antecedent typographical error has been corrected by the above amendment to claim 1.

It is respectfully submitted that this amendment does not raise new issues as the Office Action particularly points out that the appropriate interpretation, i.e., "incident beam", was taken in reviewing the claims. Therefore, the correction of the antecedent typographical error does not change the scope or breadth of the claims.

The antecedent informality of claim 23 has been corrected as well.

Withdrawal of this objection is respectfully requested.

DOUBLE PATENTING REJECTION

Claims 1-29 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claim 25 of copending application Serial No. 10/620,810 ('810), in view of Nakanishi et al., U.S. Patent No. 5,969,832. Claims 1-29 stand further provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claim 1 of copending application Serial No. 10/644,883 ('883), in view of Nakanishi et al.. These rejections are respectfully traversed.

It is respectfully submitted that the outstanding obviousness-type double patenting rejections are improper.

In both rejections, regarding applications '810 and '883, the Office Action has relied upon the disclosure of each application to reject the claims. Though the initial sentence setting out the rejection cites particular claims that are being modified by a feature in Nakanishi et al., the underlying rejection particularly cites that the application is being utilized to support the provisional obviousness rejection. See the rejection based on application '810, stating: "[t]he '810 application teaches everything except a color separation hologram [and] instead teaches a spectroscope for separating the multi light incident....All other things are either taught by the '810 application alone or in combination with Nakanishi as [outlined] in the above 35 USC 102 rejection based on Nakanishi." Also see the rejection based on application '883, stating: "[t]he '883 application teaches everything except a color separation hologram and a projection lens....Since the '883 application is silent on how to separate the light and Nakanishi teaches one well-known way of separating it; specifically Nakanishi teaches using holograms in combination with a scrolling unit instead of dichroic arrays...that this improves light utilization and resolution."

In provisional obviousness type double patenting rejections, the body of the application cannot be used to support the rejection, the rejection must be based on what the claims recite. See MPEP § 804(II)(B)(1). These rejections particularly point to the underlying applications to support the obviousness rejections, which is improper.

In addition, as noted in this MPEP section, "any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 USC § 103 obviousness determination."

To support the obviousness determinations, e.g., supporting the rejection of claims 1-29 based on claim 25 of application '810, the Office Action has recited that Nakanishi et al. sets forth the use of "holograms in combination with a scrolling unit instead of dichroic arrays...and teaches in col. 12, lines 20-32, that this improves light utilization and resolution." This benefit of using holograms to improve "light utilization and resolution" is again recited as the motivation for the modification claim 1 of application '883 to use a hologram, noting that in this rejection the Office Action argues that since claim 1 of application '883 would need a light separator it would have been obvious to add a well-known light separator, such as the hologram of Nakanishi et al.

First, the underlying assumption in the rejection based on the '810 application is that the spectroscope of claim 25 is the same as the color filter described in Nakanishi et al., reciting "the conventional one-panel projection system using a color filter," recited in col. 12, lines 28-31, which Nakanishi et al. indicates is inferior to the corresponding Nakanishi et al. one-panel projection.

However, claim 25 of application '810 only sets forth "a spectroscope separating the multi light incident from the spiral lens disc into color light beams having different wavelengths." Claim 25 does not limit the spectroscope to a single one-panel color filter, as interpreted in the Office Action. Nakanishi et al. describes differences between three-panel systems and single panel systems, in col. 1 of Nakanishi et al., and notes in col. 12 that the one-panel projection system described by Nakanishi et al. is superior to the conventional one-panel projection system. As further detailed in col. 1, Nakanishi et al. details that since the conventional one-panel projection system only filters one color at a time the resolution of the one-panel system is only 1/3 as that of the three-panel system, which can filter multiple colors at a time.

The improved Nakanishi et al. system would appear to improve over the conventional one-panel systems in that multiple colors can be filtered at the same time like the three-panel systems. Thus, the cited motivation relied upon in the Office Action is to use the system of Nakanishi et al., rather than a conventional one-panel system, to filter multiple colors at the same time.

Conversely, as noted above, independent claim 25 of application '810 does not limit the spectroscope to this conventional one-panel design. To further understand the meaning of the claimed spectroscope, application '810 clearly evidences in FIG. 2, and beginning on paragraph [0052], that the claimed spectroscope is not limited to a single color filtering system. Thus, the spectroscope of application '810 would not suffer from the problem or deficiency described in Nakanishi et al., making the purported motivation irrelevant to the system described in claim 25 of application '810. Therefore, the fact that Nakanishi et al. uses a hologram is irrelevant since there is no motivation for adding the same to the system of claim 25 of application '810.

Thus, the addition of the hologram of Nakanishi et al. to claim 25 of application '810 would not have been obvious.

In addition, to reject the remaining claims, 2-29, the Office Action relies on the previous § 102 rejection, based on Nakanishi et al.

However, each rejection of each claim 2-29 must also be supported by prima facie obviousness rationale. The fact that Nakanishi et al. discloses a feature is irrelevant without corresponding motivation for the addition of the same to claim 25 of application '810. Therefore, these rejections are improper. The rejection of claims 2-29, based on application '883, similarly fails to present any prima facie obviousness remarks for each claim 2-29. Again, the fact that a feature may be disclosed in Nakanishi et al. is irrelevant unless there is a motivation for adding that feature to claim 1 of application '883, plus this motivation and supporting remarks must be presented in the Office Action or the rejection fails to meet the prima facie obviousness case standard.

Similar to above, where the Office Action relies on the discussion in Nakanishi et al. of improved light utilization and resolution, to support the addition of hologram to claim 1 of application '883, it is respectfully submitted that this motivation is irrelevant since the rejection has failed to provide the motivation as to why it would have been obvious to modify the particular system of claim 1 of application '883.

Merely because Nakanishi et al. sets forth one way of separating light into different wavelengths doesn't mean that it would have been obvious to modify the same into claim 1 of application '883. There must be some reason for this addition. Essentially the Office Action is indicating that it would have been obvious to try the system of Nakanishi et al. with the system of claim 1 of application '883.

Again, to set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference.

In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

Further, the underlying argument in this rejection is that because the claimed light emitting units emit light beams of different wavelengths, then this can include white light, and since this includes white light, the corresponding system of claim 1 of application '883 would need a way to separate the white light, and since claim 1 doesn't disclose this separation device, it would have been obvious to try the hologram of Nakanishi et al. therein.

However, this logic fails because claim 1 of application '883 does not require the emitters to emit white light. Rather, claim 1 particularly recites that the emitting units emit light of different wavelengths, i.e., the wavelengths emitted from one emitting unit is different from the wavelength emitted from a second emitting unit. To take the interpretation that this feature could mean that the emitting units emit white light would make the term "different" irrelevant. This term must have some meaning, i.e., it must further define the light emitted from the emitting units, otherwise this term is not being given any weight. Thus the interpretation of the claim 1 of application '883 is incorrect. Also see claim 20 of application '883 as evidence of how this "different" term should be interpreted.

Thus, it is respectfully submitted that this addition of the hologram of Nakanishi et al. would not have been obvious and the underlying rationale for the addition of the same is also improper. As noted above, it is further noted that the remaining rejections of claims 2-29 are also improper, as no obviousness rationale has been presented.

Therefore, for at least the above, it is respectfully requested that these rejections be withdrawn.

REJECTION UNDER 35 USC 102

Claims 17-18 and 21-29 stand rejected under 35 USC § 102(b) as being anticipated by Nakanishi et al. This rejection is respectfully traversed.

Independent claims 17, 21 and 24 have been amended to recite that the claimed scrolling is accomplished through spirally arranged lenses.

It is respectfully submitted that Nakanishi et al. fails to disclose at least these claimed spirally arranged lenses. In addition, it is respectfully submitted that it would not have been obvious to modify Nakanishi et al. to include the same, as the system in Nakanishi et al. is particular to the parallel rotation of differently wavelength indexed portions of a hologram, which is quite different from the claimed spirally arranged lens operations. They are substantially different scrolling operations.

Therefore, for at least the above, it is respectfully requested that this rejection of independent claims 17, 21 and 24 be withdrawn. In addition, for at least similar rationale, it is respectfully submitted that claims depending from independent claims 17, 21 and 24 are also in proper condition for allowance.

CONCLUSION

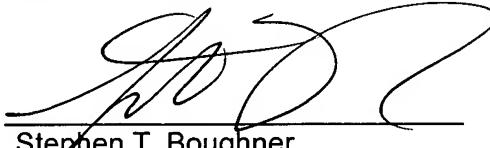
There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By: 
Stephen T. Boughner
Registration No. 45,317

Date: September 20, 2004

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501